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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,265	07/25/2000	MICHAEL DAVID NEWTON	3315/23	1881

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EXAMINER

ROBERTS, PAUL A

ART UNIT	PAPER NUMBER
3731	11

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/509,265

Applicant(s)

NEWTON, MICHAEL DAVID

Examiner

Paul A Roberts

Art Unit

3731

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 3/11/03.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- 1) Certified copies of the priority documents have been received.
- 2) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> .	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

1. Applicant's arguments filed 3-11-03 have been fully considered but they are not persuasive. The applicant incorrectly contends that Jackson GB 2,214,678 does not disclose every element as claimed by the applicant, particularly a communication means on each the pump and the article, wherein at least one of said communication means is capable of identifying the article and instructing the control means to activate the pump accordingly.
2. As disclosed in page 6 lines 5-8, the code rings (communication means A), are read by the reading head (communication means B) and the reading head is part of the mounting head. It is inherent that this Jackson embodiment would function the same as the rest of the Jackson device except where stated. The code rings on communication means A are machine-readable. Thus machine/communication means B can read them (page 1, line 12.) The pump/reader combination then acts on the information provided by communication means A (lines 5-8, page 3.)
3. Regarding the argument of identifying the item. The pump reader receives information from the tyre identifying the amount of pressure to place into the tyre. The reader has thus identified the tyre (an inflatable article) as a tyre requiring a predetermined pressure. Thus Jackson has disclosed all the elements of the claim.
4. Regarding the argument about lying on the tyre. This claim (5) recites intended use of the applicant's device. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). For this reason, it is not relevant whether a tyre is normally used as a support to lie. A tyre is capable of being used a patient support. It is also not relevant that the applicant considers it unfair of the examiner to suggest that a tyre is normally used as a support for a patient to lie on, because the examiner did not suggest a tyre is normally used as a patient support, rather the examiner merely contends that a tyre could be used for the said purpose.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 & 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson, UK Patent Application 2 214 678. Jackson discloses a pneumatic control system containing at least one inflatable/deflatable article (the tyre):

- a control means (override switches page 5, line 12) to operate the pump (page 4, line 23)
- a connection means (items 8 & 9)
- communication means provided on the tyre, the valve (abstract,) and a communication means provided on the pump (item 8, figure 3.) When the valve is placed into the valve reader information is exchanged and the pump identifies the tyre and inflates the tyre to its correct pressure (page 6, lines 5-8.)

7. Regarding claim 2, the communication means is capable of exchanging information. The valve contains a bar code which the reader observes and then inflates the inflatable accordingly.

In pages 3-4; beginning on line 25, page 3 and terminating on line 3, page 4 this process is described, however this passage describes the embodiment using the tyre cap. An analogous process would inherently be undertaken to inflate the article for the tyre valve embodiment.

8. Regarding claim 3, the communication means is provided within (“inside the fixed limits of; not beyond”<sup>1</sup>) the connection means.

9. Regarding claim 4, if the tyre valve is taken to be the communication means on the article and the reader on the pump is taken to be the second communication means and these communication means use magnetic energy or a bar code reader as suggested in the third paragraph of the first page, the tyre valve and the reader would not come into physical contact at anytime during the inflation/deflation process.

10. Regarding claims 5-7, a tyre can be used as a support to lie on.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson, in view of Write, US patent # 3,570,495. Jackson discloses a pneumatic device used for inflating articles, especially tyres. Jackson fails to disclose that the apparatus could be used to inflate

garments, such as an inflatable tourniquet. Since different tourniquets can have different pressure and volume requirements, an identifier would increase the safety and brevity of the inflation process. Write teaches in column 1, lines 53-67 that different tourniquets can be constructed for different parts of the body. He also teaches that a tourniquet can be inflated with a pump (column 3, 30-40.) It would have been obvious at the time of the invention to one skilled in the art to inflate the tourniquet for the purpose of providing pressure around a person's extremity (column 1, second paragraph.) in a rapid and safe manner by using the pneumatic Jackson device.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

PR  
Paul Roberts  
March 31, 2003

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700